UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		09/922,348	BORGER ET AL.
		Examiner	Art Unit	
		DOHM CHANKONG	2152	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 December 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-62</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-62</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1>   This action is in response to Applicant's amendment, filed 12.3.2007. Claims 1, 9, 20, 27,

39, 46, and 57 are amended. Claims 1-62 are presented for further examination.

2>   This is a final rejection.

Response to Arguments

3>   Applicant reiterates the argument that the combination of Dames, Funk, and Logan teach

away from the claimed invention. Specifically, Applicant argues that Logan teaches away from

the conversion to an audio format prior to delivery of the content to the user client. It should be

noted that Dames and Funk teach the claimed invention of conversion of content prior to

delivery of the content.

        Applicant's argument relies on the unfounded presumption that a secondary reference

must be completely combined with the primary reference in order to find obviousness. However,

the proper test for obviousness is what the combined teachings of the references would have

suggested to one of ordinary skill in the art. MPEP §2143.01(II). Where the teachings of two or

more prior art references conflict, the examiner must weigh the power of each reference to

suggest solutions to one of ordinary skill in the art, considering the degree to which one

reference might accurately discredit another. Id.

        Here, Dames and Funk teach inserting advertisements into content and translating the

content from text to audio format prior to delivery to a user device. As Applicant notes, Logan

merely teaches that a preferable method is to perform the translation at the client device. Merely

disclosing that client-side translation is a preferred method however does not mean that the translation should not or cannot be performed at the server. One of ordinary skill in the art would have not blindly followed Logan's suggestion in order to incorporate an advertisement server into Dames and Funk's teaching. Rather, one of ordinary skill in the art would balance the benefits of performing the translation at the server (as taught by Dames and Funk) or at the client (as taught by Logan).

To this end, one would realize that Logan's suggestion would require modifying Dames' invention to include a translator at every client device. Since Dames discloses performing the translation at the server, one of ordinary skill in the art would weigh the benefits of providing a translator at every client device in the system versus a single translator at the server that serves all client devices. Therefore, one of ordinary skill in the art would have been just as motivated not to have included Logan's preferred method into Dames' system and kept the translation functionality at the server.

According to Applicant's logic, in order to modify a primary reference with a secondary reference, each and every teaching and disclosure in a secondary reference must be incorporated into the primary reference in order to obtain the benefit of a single teaching within the secondary reference. There has never been a requirement that every teaching within a secondary reference must be incorporated into a primary reference. The test, as explicated above, is what the references would have suggested to one of ordinary skill in the art. Based on the foregoing, Applicant's arguments have been fully considered but they are not persuasive.

4>   Applicant also argues that Funk and Logan do not teach an advertising server. In Applicant's view, Logan's advertising database simply does not read on an advertisement server. Beyond a difference in terminology however, there is no distinction between Logan's advertising database and the claimed advertisement server. Logan's advertising library within a web server stores advertisements that can be retrieved by request. Claim 1 simply recites an advertisement server within a web server storing advertisements that can be retrieved by request. Thus, based on the claim language, Logan's advertising library reads on Applicant's claimed advertising server. Funk's information source databases can fairly be viewed as reading on Applicant's claimed advertising server as well for reasons similar to those discussed with respect to Logan.

5>   With respect to claim 57, Applicant also argues that there was not citation that taught interactive audio advertisements. However, Logan teaches that a user can use voice commands to skip through advertisements [column 15 «line 60» to column 16 «line 6»]. Hence, the audio advertisements are interactive.

        Applicant also argues that the Wu and Logan references fail to teach means for receiving notification from a text-to-speech transcode that the selected advertisement has been delivered to the client device. However, Logan does teach the claimed feature. Logan discloses sending a notice that the user has started playing the audio advertisement in the form of a usage file; this usage file serves as a notification that the user has received the advertisement and has started to play it [column 9 «lines 6-10 and 43-45» | column 12 «lines 58-67»]. Logan does not expressly state that the purpose of uploading the usage file is to signal that the user has received the advertisement. However, it is clear that the server can infer from the receipt of the usage file that

the user has received the advertisement. Applicant's claims do not specify when or what kind of notification is required. It should be noted that this change in the reasoning for the rejection of claim 57 does not constitute a new ground of rejection since their is no change in the references themselves.

6>   Additionally, Applicant has amended independent claims to recite in part retrieving an advertisement in response to the subject matter of the web content. This amendment does not overcome the prior art's teachings. Specifically, Funk discloses inserting "targeted advertisements" into the message based "on information already assembled into the message" [column 10 «lines 47-53»] or "on the selected content information" [column 18 «lines 37-39»]. This teaching reads on Applicant's new limitation. Similarly, Logan teaches selecting advertisements based on the subject matter of the content as well [column 10 «lines 55-67»].

7>   Based on the foregoing, since Applicant's arguments are not found persuasive nor do the amendments overcome the prior art's teachings, the rejection set forth in the previous action are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8>   Claims 1-56 are rejected under 35 U.S.C § 103(a) as being unpatentable over Dames et

al, U.S Patent Publication No. 2002|0129067 ["Dames"], in view of Funk et al, U.S Patent No.

5.937.162 ["Funk"], in further view of Logan et al, U.S Patent. 6.199.076 ["Logan"].

9>   As to claim 1, Dames discloses a computer system configured to integrate advertising

within Web content requested by users, comprising:

        a text-to-speech transcoder [0011, 0028], comprising:

            means for converting Web content from a text-based format to an audio format

        [0011, 0026, 0040]; and

                means for serving Web content in an audio format to a user client device via

            telephone link with the user client device [0007]; and

            a Web server that hosts Web content in a text-based format [0009, 0010 : server implied

        because Dames discloses HTML formatted content], comprising:

                means, responsive to a user request via the client device for Web content, for

            retrieving related content[0027, 0040 where: Dames discloses responsive to a user

            request, related content is retrieved to be placed into the template in place of the content

            markers];

                means for inserting the retrieved advertisement within the user requested Web

            content [0040 : inserting text related to requested content (weather)]; and

                means for forwarding the user requested Web content and related content to the

            text-to-speech transcoder for conversion to an audio format and subsequent delivery to

the user client device [0051 : "end user can listen to the content over a cellular telephone connection"].

Dames does not expressly disclose an advertisement server or inserting advertisements into the user requested content. However, such features were well known in the art at the time of Applicant's invention.

In the same field of invention, Funk is directed to a system that delivers requested content to users [column 4 «lines 12-24»]. Funk expressly discloses inserting advertisements within the Web content [column 9 «lines 49-61» | column 10 «lines 47-53»]. After insertion of the advertisements within the requested content, the requested content and the inserted advertisement can then be transferred to a voice mail service that transcodes the new content from text to speech [Figure 1 | Figure 2 «item 220» | Figure 7 | column 6 «lines 12-24 and 43-52» where : Funk does not expressly disclose that the insertion of the advertisements occurs before transcoding the content but this functionality is reasonably inferred from the disclosure. For example, Funk discloses that the insertion takes place at composition processor 706 which is a component of the service processing system 104. This newly combined content is then transmitted to the voice mail service where the content is translated].

Thus it would have been obvious to one of ordinary skill in the art to modify Dames to include Funk's advertisement insertion functionality. As noted, Dames does disclose retrieving user request related textual content and then inserting the textual content into the requested content. Dames already discloses inserting related content, such as sports scores, weather and financial news [0027, 0040]. Funk would improve upon Dames system by allowing

for advertisements that are targeted to the user or even based on the requested content being delivered to the user [column 10 «lines 47-52»].

Funk does not expressly disclose an advertisement server but does disclose that the service processing system (where the advertisement insertion takes place) has access to source information databases that host information in a text-based format [column 9 «lines 49-61» | column 10 «lines 58-64»]. Furthermore, Logan expressly discloses an advertisement server that host advertisements in a text-based format [Figure 1 «item 135» | column 5 «lines 47-59»]. Logan discloses that the benefits of advertisements in a text-to-audio system include providing a means of defraying subscription costs and enabling companies to provide targeted advertising [column 44-67»]. It would have been obvious to one of ordinary skill in the art to incorporate an advertisement server as taught by Funk and Logan into Dames to have a database that stores general or targeted advertisements into requested content. It should be noted that Logan is only being relied upon to teach an advertisement server and not being relied upon to teach insertion of advertisements into web content.

10>   As to claim 2, Dames discloses selecting related content for insertion within user-requested web content in response to a user request for web content [0040]. Dames does not expressly disclose an advertisement server. However, such a feature was well known in the art at the time of Applicant's invention. Funk discloses advertisement information sources [Figure 1]. Additionally, Logan discloses utilizing an advertisement server [Figure 1 «item 130»]. It would have been obvious to one of ordinary skill in the art to have implemented Logan's advertisement server into Dames in order to incorporate advertisement functionality into Dames' text-to-

speech system. Benefits from a combination include providing a means of defraying subscription costs and enabling companies to provide targeted advertising [Logan, column 44-67»]. See also the rejection of claim 1.

11> As to claim 3, Dames discloses retrieving content having a format and size compatible with user-requested Web content when the Web content is converted to an audio format [0040]. Dames does not disclose advertisements. However, such a feature was well known in the art at the time of Applicant's invention. Funk discloses inserting advertisements into requested content based on user information and information already in the content [column 10 «lines 47-52»]. Further, Logan discloses wherein means for selecting advertisements for insert within user-requested Web content comprises means for retrieving advertisements having a format and size compatible with user-requested Web content when the web content is converted to an audio format [Figure 4 | column 18 «lines 21-45» | column 25 lines 35-50 where : Logan discloses the advertisements are inserted into a schedule table with the regular content, the advertisements in audio format like the requested content. The table ensures that the advertisements are of "compatible" size with the content as well].

Dames, Funk and Logan are concerned with providing content that will be compatible with the user-requested content [see Dames, 0011]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement scheduling functionality into Dames' system to insure that advertisements (content) inserted into content are compatible with the web content.

12>   As to claim 4, Dames does not disclose the advertisement having a predetermined time length. However, such a feature was well known in the art at the time of Applicant's invention. Logan discloses retrieving an advertisement having a predetermined time length when delivered in an audio format [Figure 4 | column 18 «lines 21-45» | column 23 «lines 40-45» | column 24 «lines 9-31» | column 25 lines 35-50 | column 34 «lines 24-44» where : the advertisement is defined as a segment of content]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement segments of predetermined length into Dames' system to provide related content that is consistent with the user-requested content.

13>   As to claim 5, Dames discloses the text-based format comprising VXML format [0026].

14>   As to claim 6, Dames does not disclose an advertisement server. However, such a feature was well known in the art at the time of Applicant's invention. Logan discloses an advertisement server further comprising means for storing information associated with serving an advertisement to a user [Figure 1 «item 130» | column 5 «lines 47-59» where : item 130 corresponds to an advertising server]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertising server into Dames to provide a central location for storing advertisements. Such an implementation is desirable for allowing quicker and more efficient access to advertisements.

15>   As to claim 7, Dames does not expressly disclose means for determining if a user listened to an advertisement in its entirety. However, such a feature was well known in the art at the time

of Applicant's invention. Logan discloses means for determining if a user listened to an advertisement in its entirety [column 10 «lines 21-29» | column 28 «lines 24-41» : "start and end times"]. It would have been obvious to incorporate Logan's billing techniques into Dames to insure that subscriber billing is accurate and based on the viewing of advertisements of the users [see Logan, column 28 «lines 42-65»].

16>   As to claim 8, Dames does not expressly disclose means for determining how many times a user listened to an advertisement. Logan discloses means for determining how many times a user listened to an advertisement [column 28 «lines 6-65»]. It would have been obvious to incorporate Logan's billing techniques into Dames to insure that subscriber billing is accurate and based on the viewing of advertisements of the users [see Logan, column 28 «lines 42-65»].

17>   As to claim 9, as it substantially has the limitations of claim 1, see the rejection of claim 1, above, under Dames, Funk, and Logan. Claim 9 differs primarily because it is directed towards interactive advertisements. Logan teaches interactive advertisements [column 27 «lines Logan discloses means for notifying the advertisement server of user interaction with an advertisement [column 28 «lines 6-65»]. It would have been obvious to incorporate Logan's billing and advertisement functionality into Dames to insure that subscriber billing is accurate and based on the viewing of advertisements of the users [see Logan, column 28 «lines 42-65»].

18>   As to claim 10, Dames does not teach the claimed limitations. However, such features was well known in the art at the time of Applicant's invention. Logan teaches:

means for retrieving additional information associated with an advertisement in response to user interaction with the advertisement [column 10 «lines 44-67» | column 31 «lines 14-62»]; and

means for delivering the additional information to the user client device in an audio format [column 31 «lines 14-62» where : hyperlinks retrieve further content. Logan teaches throughout his disclosure that his content includes text and audio format content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Dames to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

19>   As to claim 11, Dames does not teach the claimed limitations. However, such features was well known in the art at the time of Applicant's invention. Logan teaches :

means for recognizing one or more key words spoken by the user during delivery of an advertisement [column 31 «lines 48-62» : "voice command response"]; and

means for redirecting the user client device to additional audio content associated with the advertisement in response to recognition of one or more key words spoken by the user [column 31 «lines 14-62» where : hyperlinks retrieve further content. Logan teaches throughout his disclosure that his content includes text and audio format content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Dames to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

20> As to claim 12, Dames does not disclose means for retrieving additional information from the advertisement server. However, such features was well known in the art at the time of Applicant's invention. Logan discloses means for retrieving additional information in response to user interaction comprises means for retrieving additional information from the advertisement server [column 3 «lines 22-31» | column 17 «lines 18-27»]. It would have been obvious to one ordinary skill in the art to modify Dames with Logan's advertisement interaction functionality. It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Jimenez to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

21> As to claims 13 and 31, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 2.

22> As to claims 14, 15, 21, 22, 32, 33, 40, 41, 50 and 51, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 3 and 4.

23>   As to claims 16, 23, 34, 42 and 52, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 5.

24>   As to claims 17-19, 24-26, 35-38, 43-45, and 53-56, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 6-8.

25>   As to claims 20, 27, 39 and 46, as they do not as it does not teach or further define over the previously claimed limitations, they are similarly rejected for at least the reasons set forth for claims 1 and 9.

26>   As to claims 28 and 47, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the reasons set forth for claim 10.

27>   As to claims 29 and 48, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 11.

28>   As to claims 30 and 49, as the y do not teach or further define over the previously

claimed limitations, they are similarly rejected for at least the same reasons set forth for

claim 12.

29>   Claim 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, U.S

Patent Application No. 2003|0212759, in view of Logan.

30>   In regards to claim 57, Wu discloses a advertising server (figure 4-#54) that integrates

interactive advertising within Web content requested by users ([0027] lines 12-15, [0032] lines

1-6), comprising:

        means for selecting an advertisement for insertion within Web content requested by a

user via a client device [0027, 0032] in communication with a Web server (figure 4), wherein the

advertisement has a text-based format ([0025] lines 29-31) and is configured to be interactive

when converted to an audio format;

        means for forwarding the selected advertisement to the Web server for insertion within

the Web content requested by the user [0020, 0032 : delivered "in-band" with the requested

content]; and

        means for receiving notification from a text-to-speech transcoder that the selected

advertisement has been delivered to the user client device in an audio format [Logan, see

response to arguments above];

Wu is silent on means for storing information associated with delivery of the advertisement to the user client device and on selecting advertisements based on subject matter of the web content.

As to the first feature, Logan discloses interactive advertisements and storing information associated with delivery of the advertisement to the user client device [column 27 «line 58» to column 28 «line 65» where the server stores information about how the user played the advertisement such as volume and whether any ads were skipped]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement tracking functionality into Wu's advertising system to benefit the companies by providing useful information to better target and utilize their advertisements [see Logan, column 28 «lines 42-57»].

As to the second feature, Logan teaches selecting advertisements based on the subject matter of the content as well [column 10 «lines 55-67»]. It would have been obvious to one of ordinary skill in the art to have modified Wu with Logan's teaching of providing advertisements based on subject matter to consumers. Such a feature enables targeted advertising.

31>   In regards to claim 58, Wu does not disclose storing information associated with user interaction. Logan discloses storing information associated with user interaction with the advertisement [column 22 «lines 20-25» | column 28 «lines 6-65»].

32>   In regards to claim 59 Wu discloses the advertisement server of claim 57, further comprising means for providing additional information associated with the advertisement to the

user client device in response to user interaction with the advertisement ([0027] lines 12 – 24, [0041] lines 6-20).

33>   As to claims 60 and 61, Wu does not expressly disclose retrieving advertisements having a format and size compatible with the user requested content or the advertisements having a predetermined time length.

34>   As to claim 60, Logan discloses wherein means for selecting advertisements for insert within user-requested Web content comprises means for retrieving advertisements having a format and size compatible with user-requested Web content when the web content is converted to an audio format [Figure 4 | column 18 «lines 21-45» | column 25 lines 35-50 where : Logan discloses the advertisements are inserted into a schedule table with the regular content, the advertisements in audio format like the requested content. The table ensures that the advertisements are of "compatible" size with the content as well].

As to claim 61, Logan discloses retrieving an advertisement having a predetermined time length when delivered in an audio format [Figure 4 | column 18 «lines 21-45» | column 23 «lines 40-45» | column 24 «lines 9-31» | column 25 lines 35-50 | column 34 «lines 24-44» where : the advertisement is defined as a segment of content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement scheduling functionality into Dames' system to insure that advertisements (content) inserted into content are compatible with the web content. Ensuring compatibility is both desirable and advantageous to the user and the content provider.

35>   In regards to claim 62, Wu discloses the advertisement server of claim 57, wherein the text-based format comprises voice extensible markup language (VXML) format ([0028] lines 11-17).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

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Application Information Retrieval (PAIR) system. Status information for published applications

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information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152